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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/112,131 07/08/98 WALKER

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TM02/1206

EXAMINER

NGUYEN, C

ART UNIT

PAPER NUMBER

2165

DATE MAILED:

12/06/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/112,131

Applicant(s)
Walker et al.

Examiner
Cuong H. Nguyen

Group Art Unit
2165



☒ Responsive to communication(s) filed on Sep 5, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

- ☒ Claim(s) 177-189 and 192-195 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 177-189 and 192-195 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 20
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

2365uDETAILED ACTION

1. This Office Action is the answer to the communications received on 9/05/2000 (the amendment, and the remarks); which paper has been placed of record in the file.

2. Claims 177-189, 192-195 are pending in this application.

Response to the amendment:

3. Due to the amendment & remark, previous rejections on 35 U.S.C. 103(a) are withdrawn, the examiner submits that new ground of rejections based on 35 U.S.C. 103(a) are made. Hence, the arguments are moot.

4. The following rejections are based on the examiner's broadest reasonable interpretation of the claims, *In re Pearson*, 181 USPQ 641 (CCPA 1974).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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6. Claims 177-189, 192-195 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen (US Pat. 5,948,054), in view of Harte (US Pat. 4,576,579), and further in view of the Official Notice.

A. Claims 177-178 are rejected because they "read-on" the steps of "expert matching" e.g. the USPTO Commissioner/the representative's attorney (the end user of a patent application), the examiner (an expert/master in his field by art unit/(classification subject), the Supervisory Patent Examiner (second expert who has a higher experience/authority compared to the first expert (his examiner). A patent application is transmitted to an examiner (first expert), he examines the case, and then get some advices from his SPE (second expert); this 2nd expert approves who is right in his art unit for the job of examining this particular case (e.g. depending on a specific subject matter such as insurance, e-shopping, e-coupons, banking, .etc., he appoints one of his examiner who is expert in this specific field; the SPE is always a senior, experience examiner who can guarantee his examiner 's level of expertise to the Commissioner/the representative's attorney (the end user). Therefore, this rationale/reference would read-on the claim's language.

B. Referring to claims 192-195: The field of application is "expert matching" with assistance of a computer system.

Nielsen obviously suggests an expert matching computer for managing communications between an expert and an end user (see **Nielsen**, the abstract; Figs.6, 7), comprising:

- inherent features of a controller unit for receiving an end user request (see **Nielsen** Fig.1 refs.139, 143; Fig.4), the controller unit having a database for storing therein a plurality of expert qualifications (see **Nielsen** Fig.1 refs.139, 143), each expert qualification associated with an expert address stored in the database and corresponding to a particular expert (see **Nielsen** Fig.1, refs. 139, 143, Figs.2, 5);

- inherent features of a means for classifying request (see **Nielsen** the abstract, Figs.2, 3, 5, 7 refs.213, 305);

- inherent features of a means for providing an expert address which corresponds to a request's classification (see **Nielsen** Figs.1, 2, 3, 5 refs. 213, 305);

- inherent features of a means to identify:

- an expert corresponding to a request's field/classification; an identified expert address corresponding to the identified expert (the Official Notice is taken here that these features of the claim are notoriously well-known in the art

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(e.g. a Patent & Trademark Office's examiner who examines applications of a particular US Classification (for example class 705 subclass 28); his art unit, Technology Center, his phone number, his Office location .etc.; see also Hart for implicit suggestions);

Nielsen does not disclose exactly a claim's language in using his concept as claimed by the applicants.

However, the Official Notice is taken here that all the claimed limitations are analogously well-known in the above field. For example, a controller unit for receiving a request to grade a multiple choice test, it would define a testing level and selecting an appropriate test level questions (a requested expert qualification), this controller unit (computer using for testing) having a database for storing a plurality of test levels/(expert qualifications), each stored level/(different expert qualification) corresponding to an appropriate test/(expert of a plurality of sub-level experts), each stored test answer template/(expert qualification) being associated with an address stored in the database and corresponding to a test/an expert .etc. (see Hart for these implicit suggestions). Then, these means are obviously involved in this test that the examiner takes Official Notice:

- means for selecting/searching the database to identify a test/expert corresponding to the requested test/qualification and an address corresponding to the identified test (see Hart for these implicit suggestions);

- means for requesting management 's approval of a specific test (a standard of qualification) to a corresponding level of grade; and means to receive a response on that matter (this is analogous to "receiving a signal from the second expert (e.g. from manager) that indicates approval of the first expert qualification (a specific test)", and similar as above to "receiving a signal from the set of experts (e.g. many supervisors) that indicates approval of the first expert qualification") (see Hart for these implicit suggestions) (this response also answers arguments on para.2,4-5 of page 4 in the amendment received on 9/05/2000; see also *In re Venner*, 262 F.2d 91, 120 USPQ 193, 194 (CCPA 1958)).

- means for authenticating data (e.g. checking tester's I.D., and picture I.D., checking authorized personnel in a test room .etc.);

- means for guaranteeing payment to the selected test (a test fee is administered in order to take the test or in order to have test results);

- means for initiating remittance of payment to a test (application accompanying a testing fee as initiation);
- means for selecting the end user requests for test evaluation (e.g. a teacher, a student, an employer);
- means for transmitting a portion of test result to the address corresponding to an identified result template (e.g. for adjusting the result in a test template);
- means for receiving a test answer/result in response to the end user request (the Official Notice is taken here that this means is notoriously well-known in the art for receiving a test result e.g. from a teacher);
- means for transmitting test answers to the end user (the Official Notice is taken here that this means is notoriously well-known in the art for transmitting test answers e.g. to an employer);

In other words, these limitations can be done exactly by a computer system from a testing lab (see Hart for these implicit suggestions). One of ordinary skills in the art at the time of the invention would have found these claim's limitations would be very obvious with inherent steps as suggested by cited prior art; prior art's limitations are not necessary spelled-out exactly claimed languages, because these prior arts are also directed to a similar process for obtaining job applications from remotely

located applicants. These prior arts are not limited to the described embodiments in these inventions. It is reasonable that various modifications and variations of the described method and system of the cited prior art would be apparent to those skilled in the art without departing from the scope and spirit of the invention. Although these inventions have been described in connection with specific preferred embodiments, it should be understood that the invention as claimed should not be unduly limited to such specific embodiments.

It would have been obvious to one of ordinary skill in the art at the time of invention to implement the same concept of testing a level/(an achievement) to perform functions as claimed; because all cited references would suggest using a similar means and applying a similar concept as a expert matching computer to select an appropriate source for a specific solution.

C. Referring to claims 177-189: The limitations of these claims recite the same claim limitations as claims 192-195 discussed above. The same analysis and reasoning set forth above in the rejection for obviousness of claims 192-195 applied to these claims also because they are just computer and method claims for the above device; moreover these claims may have more broader limitations. The examiner considers specific limitations that the applicants said "significant limitations" are

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inherent/obvious in the rationale/prior art in claim 177-189 since they are notoriously well-known in the business art.

Conclusion

7. Claims 177-189, 192-195 are rejected.

8. The following references are considered pertinent to applicants' disclosure.

- Nielsen (US Pat. 5,948,054 filed on 2/27/1996) published on 9/07/1999, about a method and a system for facilitating the exchange of information between human users in a networked computer system.

- Esther Dyson, "Information, bid and asked", Forbes, v146, n4, p92(1), 8/20/1990; (from Dialog(R) file 47).

9. Remarks: A. About automating a manual activity:

A. The court held that providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. *In re Venner*, 262 F.2d 91, 120 USPQ 193, 194 (CCPA 1958).

B. About applicant's argument of cited reference "Teaching Away"
Ex parte Rubin, 5 USPQ2d 1461 (BdPatApp&Int 1987), the court said:
Knowledge in the art may have advanced such that results considered incredible are no longer per se incredible.

C. *In re Susi*, 169 USPQ 423 (CCPA 1971), the court said:

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Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments.

D. About "read-on" with claimed languages

In re **Hiniker Co.**, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998)
the court said: "The name of the game is the claim."

Although operational characteristics of an apparatus may be apparent from the specification, we will not read such characteristics into the claims when they cannot be fairly connected to the structure recited in the claims. See In re **Self**, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982). When given their broadest reasonable interpretation, the claims on examination sweep in the prior art, and the prior art would have directed an artisan of ordinary skill to make the combination cited by the examiner. ... discloses a structure that meets the claim limitations. See **Giles Sutherland Rich**, Extend of Protection and Interpretation of Claims -- American Perspectives, 21 Int'l Rev. Indus. Prop. & Copyright L. 497, 499 (1990) ("The US is strictly an examination country and the main purpose of the examination, to which every application is subjected, is to try to make sure that what each claim defines is patentable. To coin a phrase, the name of the game is the claim"). Hence, further amendments must be made to improve the form of the claims.

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E. Although claims' limitation may be apparent from specification, they will not be read into claims when they can not be fairly connected to structure recited in claims, and since, when given their broadest reasonable interpretation, claims in present application sweep in cited prior art which would have directed artisan of ordinary skill to make cited combination.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Cuong H. Nguyen, whose telephone number is (703)305-4553. The examiner can normally be reached on Mon.-Fri. from 7AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent a. Millin, can be reached on (703)308-1065.

Any response to this action should be mailed to:

Box Issue Fee

Amendments

Commissioner of Patents and Trademarks

c/o Technology Center 2100

Washington, D.C. 20231

or faxed to: (703) 308-9051, (for formal communications)

Or: (703) 305-0040 (for informal or draft communications)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-3900.

Cuong H. Nguyen
Cuong H. Nguyen
Nov. 27, 2000